# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/051,278 | 01/22/2002 | Hiroya Kumashio | 217967US2 | 7574 |

| | | | EXAMINER |
|---|---|---|---|
| 22850 | 7590 | 03/31/2006 | POKRZYWA, JOSEPH R |

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| ART UNIT | PAPER NUMBER |
|---|---|
| 2625 | |

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on _17 January 2006_.

2a)☒ This action is **FINAL.** 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under _Ex parte Quayle_, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) _2,4-9 and 11-13_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _2,4-9 and 11-13_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _2/3/06_.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

# DETAILED ACTION

## *Response to Amendment*

1.      Applicant's amendment was received on 1/17/06, and has been entered and made of

record. Currently, **claims 2, 4-9, and 11-13** are pending.

## *Response to Arguments*

2.      Applicant's arguments, see pages 6-8, filed 1/17/06, with respect to the previous

rejections cited in the Office action dated 9/14/05 of the presently amended claims 2,4-9, and 11-

13 have been fully considered and are persuasive. The newly added features overcome the cited

art of Kageyama *et al.* (U.S. Patent Number 5,625,757) and Owa *et al.* (U.S. Patent Number

6,348,971). Therefore, the rejections have been withdrawn. However, upon further

consideration, a new ground(s) of rejection is made in view of Tonkin (U.S. Patent Number

6,134,568).

## *Information Disclosure Statement*

3.      The references listed in the Information Disclosure Statement submitted on 2/3/06 have

been considered by the examiner (see attached PTO-1449).

## *Claim Objections*

4.      **Claim 11** is objected to because of the following informalities:

In *claim 11*, line 12, "said document supervisory client" should read "said first computer".

        Appropriate correction is required.

## *Claim Rejections - 35 USC § 102*

5.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

6.      **Claims 2, 4-9, and 11-13** are rejected under 35 U.S.C. 102(b) as being anticipated by

Tonkin (U.S. Patent Number 6,134,568).

Regarding *claim 2*, Tonkin discloses a printing system (see Fig. 1) having at least one

printer (document production locations 71-73) comprising a document supervisory client

(terminals 31 or 32) configured to generate at least one print condition setting (see Figs. 5A-5F,

column 7, lines 11-column 8, line 53), and a document supervisory server (processing facility

60) configured to perform printing based upon a printing request from the document supervisory

client in accordance with the print condition settings (column 13, lines 1-24, and column 13, line

52-column 14, line 23), wherein the document supervisory client makes a query to the document

supervisory server via a network if the print condition settings are appropriate in a printer

(column 9, line 24-column 10, line 43), the document supervisory server returns advisability of

the print condition settings to the document supervisory client (column 9, line 24-column 10, line

43), wherein the document supervisory server changes a combination of the print condition

settings (column 9, line 24-column 10, line 22), and sends an appropriate combination including

one set of changed print condition settings to the document supervisory client when determining

the print condition settings are inappropriate (column 9, line 24-column 10, line 43), and wherein

the document supervisory client generates a user interface based on the one set of changed print condition settings (see Figs. 8A-9).

Regarding *claim 4*, Tonkin discloses a printing system (see Fig. 1) comprising a first computer including a document supervisory client (terminals 31 or 32) configured to generate at least one print condition setting (see Figs. 5A-5F, column 7, lines 11-column 8, line 53), and a second computer including a document supervisory server (processing facility 60) configured to perform printing based upon a printing request from the document supervisory client in accordance with the at least one print condition setting (column 13, lines 1-24, and column 13, line 52-column 14, line 23), and at least one printer connected to a network (document production locations 71-73), wherein the document supervisory client makes a query to the document supervisory server via the network if the print condition settings are appropriate in one of the at least one printer (column 9, line 24-column 10, line 43), the document supervisory server returns advisability of the print condition settings to the document supervisory client (column 9, line 24-column 10, line 43), wherein the document supervisory server changes a combination of the print condition settings (column 9, line 24-column 10, line 22), and sends an appropriate combination including a changed set of print condition settings to the document supervisory client when determining the print condition settings is inappropriate (column 9, line 24-column 10, line 43), and wherein the document supervisory client generates a user interface based on the changed set of print condition settings (see Figs. 8A-9).

Regarding *claim 5*, Tonkin discloses the system discussed above in claim 2, and further teaches that the document supervisory server sends initial setting values with applicable character strings and graphs each representing pint condition settings to the document

supervisory client (column 13, lines 1-24, and column 9, line 24-column 10, line 43), and the

document supervisory client generates a user interface configured to allow print condition

settings based upon the setting values, character strings, and graphs (column 9, line 24-column

10, line 43).

Regarding *claim 6*, Tonkin discloses the system discussed above in claim 5, and further

teaches that the document supervisory server changes a combination of the print condition

settings (column 9, line 24-column 10, line 43) and sends an appropriate combination including

one set of changed print condition settings to the document supervisory client when determining

the print condition settings are inappropriate combination (column 9, line 24-column 10, line 43).

Regarding *claim 7*, Tonkin discloses the system discussed above in claim 4, and further

teaches that the document supervisory server sends initial setting values with applicable

character strings and graphs each representing pint condition settings to the document

supervisory client (column 13, lines 1-24, and column 9, line 24-column 10, line 43), and the

document supervisory client generates a user interface configured to allow print condition

settings based upon the setting values, character strings, and graphs (column 9, line 24-column

10, line 43).

Regarding *claim 8*, Tonkin discloses the system discussed above in claim 7, and further

teaches that the document supervisory server changes a combination of the print condition

settings (column 9, line 24-column 10, line 43) and sends an appropriate combination including

one set of changed print condition settings to the document supervisory client when determining

the print condition settings are inappropriate combination (column 9, line 24-column 10, line 43).

Regarding *claim 9*, Tonkin discloses the system discussed above in claim 4, and further

teaches that the document supervisory client is configured to send an ID which uniquely

identifies a document stored in a database in a document supervisory server (column 6, line 51-

column 7, line 27, and column 13, lines 26-64), and the document supervisory server obtains an

applicable document corresponding to the ID and executes printing the applicable document in

accordance with the print condition settings (column 13, line 26-column 14, line 23).

Regarding *claim 11*, Tonkin discloses a printing method comprising the steps of

generating prescribed print condition settings in a first computer (see Figs. 1, 5A-5F, column 7,

lines 11-column 8, line 53, in terminals 31 or 32), transmitting a query to a second computer

(processing facility 60) via a network if the print condition settings are appropriate in a printer

(document production locations 71-73) connected to the network (column 9, line 24-column 10,

line 43), returning advisability of the print condition settings from the second computer to the

first computer, and performing printing in accordance with the advisability (column 9, line 24-

column 10, line 43), determining if the print condition settings are appropriate in the printer,

changing a combination of the print condition settings to an appropriate combination (column 9,

line 24-column 10, line 22), and sending the appropriate combination to the first computer

(column 9, line 24-column 10, line 43), wherein the document supervisory client generates a user

interface based on the changed set of print condition settings (see Figs. 8A-9).

Regarding *claim 12*, Tonkin discloses the method discussed above in claim 11, and

further teaches of sending all offsetting values related to the printer as appropriate print condition

settings, applicable character strings and graphs representing initial print condition settings to the

first computer (column 13, lines 1-24, and column 9, line 24-column 10, line 43), and generating

the user interface configured to allow modification of print condition settings based upon the

setting values, character strings, and graphs (column 9, line 24-column 10, line 43).

Regarding *claim 13*, Tonkin discloses the method discussed above in claim 12, and

further teaches of sending an ID from the first computer to the second computer via the network,

the ID uniquely identifies a document (column 6, line 51-column 7, line 27, and column 13, lines

26-64), obtaining the document corresponding to the ID, and executing printing the document

based on the print condition settings (column 13, line 26-column 14, line 23).


### *Citation of Pertinent Prior Art*

7.      The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure:

        **Greulich** *et al.* (U.S. Patent Number 5,241,464) discloses a desktop forms ordering

system.


### *Conclusion*

8.      Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

        A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
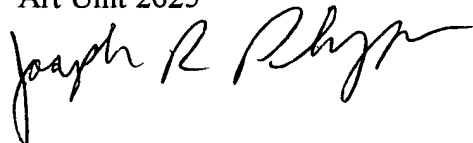
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

9.      Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The

examiner can normally be reached on Monday-Friday, 9:00-5:00.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

        Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

                                        Joseph R. Pokrzywa
                                        Primary Examiner
                                        Art Unit 2625

jrp